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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,285	10/20/2000	Leon A. Pintsov	F-214	8085

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EXAMINER

BACKER, FIRMIN

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 08/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/693,285

Applicant(s)

PINTSOV, LEON A.

Examiner

Firmin Backer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Response to Amendment

This is in response to an amendment file on June 6th, 2003 for letter for patent filed on October 20th, 2000 in which claims 1-22 were presented for examination. In the amendment, claims 16-22 have been amended, claims 1-15 have been canceled, and claims 23-36 have been added. Claims 16-36 are pending in the letter.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 23-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete and tangible result.

For a claimed to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" and therefore are found to be non-statutory subject matter. For a method claim to pass the muster, the recited method must somehow apply, involve, use, or advance the technological arts.

In the present case the inventive concept in claim 23-36 only recites an abstract idea. The recited steps do not apply, involve, use or advance the technological arts since all the steps can

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be performed in the mind of the user or by use of pencil and paper and no specific technology (e.g. computer, processor) is expressly recited in the body of the claims. *In re Toma (CCPA 197 USPQ 852 (1978))*.

Although the recited method produces a useful, concrete and tangible result, since the claimed invention, as a whole, it not within the technological arts as explained above, claim 23-36 deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 23-36 are rejected under 35 U.S.C. 102(a) as being anticipated by Pintsov '036.

Regarding claime 23-29,

Pintsov teach a method for providing value added services requested by a mailer and relating to the handling of a mailpiece by a plurality of postal authorities comprising receiving a mail item at a final handling post scanning the mail item to obtain a digital image of the mail item and an identifier for an initial handling post, obtaining a digital image of a signature of a recipient of the mail item as confirmation of delivery of the mail item, merging the digital image and the signature of the mail item and transmitting the merge digital image to the initial handling post etc. reads on figure 1, element 106 and 108 and also fig 4.

Regarding claims 30-36

Pintsov teaches a method for providing a value added services requested by a mailer and relating to the handling of a mailpiece by a plurality of postal authorities comprising receiving electronically at an initial handling post a transfer file representing confirmation of delivery of the mail item by a handling post, parsing the transfer file to retrieve digital images of the mail item and a signature of a recipient confirming delivery of the mail item and sending to the mailer confirmation of delivery of the mail item etc. reads on figure 1, element 106 and 108 and also fig 4.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pintsov '036 in view of USPS "3 Special Services" and PS Form 2865.

Regarding claims 16,

Pintsov teaches a postage payment system with security for sensitive mailer data and enhanced carrier data functionality such that Applicant's step of combining a set of value-added services into a machine readable mark on a mailpiece reads on figure 1, element 108, Applicant's step of reading said mark at a second handling postal authority reads on the destination country receiving the mailpiece and interpreting the mark, Applicant's step of performing the valued

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added service reads on the destination country performing the value-added service, Applicant's step of sending a message to said first handling postal authority reads on the destination country (second handling postal authority) sending completed form 2865 to the first handling postal authority (USPS) and Applicant's step of determining an original mailer electronic address at said first handling authority reads on element 106. Pintsov further teach and inventive concept of communicating the performance of the value added service to the first postal authority to the mailer using the mailer's address.

While Pintsov does not teach the use of his system for international purposes, the USPS has a relationship with many countries wherein value added services, such as return receipt/confirmation of delivery, are performed. As evidenced by the PS Form 2865, the value added service of return receipt between the USPS and other countries has been performed at least since March of 1985. Applicant's creating a machine readable mark for the processing of domestic mail, including a mailer identification code and value-added service data, is disclosed in Pintsov '036 which dates as far back as July, 1994. USPS "3 Special Services" indicates the procedure the other country follows with regard to the value-added service of return receipt for international mailpieces. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Pintsov '036 to include international handling of value added service requests along with it's handling of domestic mail as it will widen the marketability, and thus profits, of the Pintsov '036 system and streamline the handling of value added services regardless of whether the mail is domestic or international.

Regarding claim 17:

Pintsov '036 teach a system to encrypted the mailer identification code

Regarding claims 18-19:

Pintsov '036 teach a system wherein the first database includes the mailer email address and the second database includes the postal authority email address.

Regarding claims 20-22:

While Pintsov '036 does not disclose notification via fax or telephone, it is considered that it would have been obvious to one of ordinary skill in the art that this notification could be done either by fax or telephone as a matter of design choice as these are considered to be similar forms of communication.

Regarding the newly added claims 23-36, they disclose the same inventive concept as claims 16. Therefore they are rejected under the same rationale.

Response to Arguments

7. Applicant's arguments filed June 6th, 2003 have been fully considered but they are not persuasive.

a. Applicant argues that the reference cited neither alone or in combination disclose nor suggest the claim inventive concept. Examiner respectfully disagrees with Applicant characterization of the prior art. The prior art clearly teach the inventive concept alone or in combination and that a prima facie case has been made in rejecting the claims.

Applicant argue that the prior fail to teach or suggest an inventive concept to preventing subsequent postal authorities from having access to mailers electronic address, whereby authorities would be able to communicate with the mailer and bypass the original postal authority in the future. Examiner respectfully disagrees with applicant characterization of

the prior art. An important advantage of Pintsov inventive concept is that the mailer can not repudiate his ownership of the mail piece and then the post payment billing for the mail piece, since only the mailer was in possession of the matching private key. The copying of the data printed on a mail piece by a third party does not make much economic sense since the address destination information is encrypted together with mailer's identity. Thus, a copy would have to be sent to the same destination which usually not practical. Mail pieces, that do not display mailer's identification in one way or another can not be processed in this manner because the mailer's or associated public key must be identified and used in the decryption process. As an alternative to the mailer identification, the mailer's identification can, if desired, be uniquely determined from the return address. Moreover, referring to FIG. 1. A mail piece 100 is imprinted with data blocks 102, 104, 106, 108, 110 and 112. Block 102 is the destination address. Block 104 is the origination address, which may uniquely identify the mailer. Block 106 is the mailer's unique identification number (MID) in this case 112345678907. Block 108 represents service data required by the mailer and a unique identification for the mailpiece. Block 108, specifically 01 02 33 1234567, is formed as follows. The first two digits "01" may represent a type of mail or a mail class that would typically be indicative of required delivery time, e.g. within 3 days. The second two digits "02" may represent a rating parameters such as weight, size etc. Combination of such parameters can be encoded with more than two digits if needed. For example, if there are 20 different weight categories and 6 different size classes, then the total number of possible combinations is $6 \times 20 = 120$. Each combination can be encoded with three digit number. The third group of two digits "33" may represent a service requirement, such as,

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insured letter with a confirmation of delivery. The last group of digits "1234567" is a unique mail piece identification. This may also be a consecutive non-resettable count of the mail generation system shown in FIG. 2.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

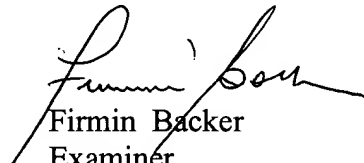
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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

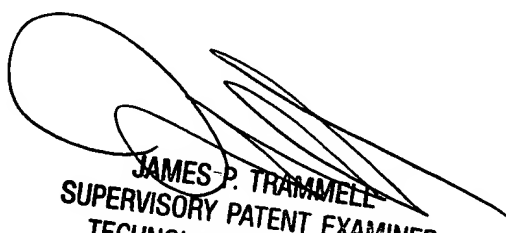
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


Firmin Backer
Examiner
Art Unit 3621

July 30, 2003


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
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